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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,585      05/28/99      KELMAN

J      P-2590-1/TAC

EXAMINER

IM22/0802

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ART UNIT

PAPER NUMBER

1732

DATE MAILED:

08/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/322,585

Applicant(s)

KELMAN ET AL.

Examiner

EDMUND LEE

Group Art Unit  
1732



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) 12-18 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a method for assembling interior vehicle trim, classified in class 264, subclass 138.
  - II. Claims 12-18, drawn to a bead forming apparatus, classified in class 425, subclass 113.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as a forming a bead on a trim for a piece of furniture as opposed to a vehicle. Also, the process as claimed can be practiced by another materially different apparatus or by hand such as an apparatus that does not support both the recess forming tool and applicator on a common mount.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Eric Jones on 7/27/00 a provisional election was made without oral traverse to prosecute the invention of I, claims 1-11. Affirmation of this

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election must be made by applicant in replying to this Office action. Claims 12-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is incomplete because the steps of the claim do not recite a method for assembling interior vehicle trim parts. The culmination of the steps of the claim create a bead mechanically connected to a first trim part.

The phrase "the trailing applicator...overflow the recess" (cl 9, lns 10-12) is indefinite and confusing because it is idiomatically incorrect.

Clarification and/or correction is required.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art as set forth on pg 1-3 of the instant specification in view of Henzl (USPN 4124676) or Reid et al (USPN 5810406). In regard to independent claim 1, the admitted prior art teaches assembling interior trim parts in which a first trim part is disposed adjacent a second trim part and in which a bead of buffer material/elastomer is provided between the first and second trim parts to reduce noises; providing a first trim part having a mating surface configured to lie alongside a mating surface of the second trim part when the first and second trim parts are disposed adjacent one another in a vehicle; extruding/providing a buffer material/elastomer on the mating surface of the first trim part; and allowing the bead to cure/harden before assembly of the trim parts. The admitted prior art also teaches that there is a problem with adhering elastomers to all the materials used to form automotive trim components and panels. However, the admitted prior art does not teach forming a recess in the mating surface of the first trim part; providing buffer material in the recess so as to provide a bead of buffer material on the mating surface; and allowing the bead to mechanically connect to the first trim part. Henzl teaches the use of mechanical bonds as opposed to adhesives to bond an elastomer to another type of plastic or another elastomer (col 1, lns 5-68; fig 7); providing cavities in one material (fig 7)--as a note, this constitutes forming cavities/recesses; providing a second material that is desired to be bonded to the first material in the cavities/recesses of the first material (fig7); and allowing the second material to harden to

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form a mechanical bond between the two mating materials (col 1, lns 5-68). Reid et al teach using a mechanical bond as opposed to adhesive tapes to mate two materials to form an automotive trim (col 1, lns 10-25 and 42-50; col 2, ln 55-col 3, ln 15; figs 2-3); and providing an inner layer with a recesses which are filled with the material of the outer layer to create a mechanical bond between the two layers (col 2, ln 55-col 3, ln 15; figs 2-3). The admitted prior art and Henzl or Reid et al are combinable because they are analogous with respect to the desire to form a stronger bond between mating materials. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of either Henzl or Reid et al (forming mechanical bonds between two mating materials by forming recesses in one material and filling those recesses with the second material) to the admitted prior art in order to overcome the problem of bonding elastomer to the various materials of the interior trim of automobiles.

In regard to claims 2-11, the admitted prior art also teaches using a robotically controlled applicator/extruder to provide the buffer material/elastomer to the mating surface of the first trim part--as a note, it is inherent that the applicator/extruder has an extrusion head and the buffer material extrudes through the extrusion head; using an elastomeric material as the buffer material; and allowing the elastomer to cure--as a note, this constitutes that the elastomer is either a thermoplastic or thermosetting elastomer. However, the admitted prior art does not teach forming a recess to include an undercut; selecting thermoplastic urethane as the buffer material; the limitations of claim 7; the limitations of claims 8-9; providing a router having a router bit; and the specific design claimed in claim 11. In regard to a recess to include an undercut, the above

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combination of the admitted prior art in view of Henzl or Reid et al teach using recesses having undercuts. In regard to selecting thermoplastic urethane as the buffer material, the use of a specific material is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the claimed material is notoriously well-known in the molding for its moldability thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed material as the buffer material of the admitted prior art in order to enhance the bond between the trim parts. In regard to the limitations of claim 7, the above combination of the admitted prior art in view of Henzl or Reid et al teach using a robotically controlled extruder/applicator that is connected to a source of fluid buffer material/elastomer to provide a bead of buffer material/elastomer in the recesses of the admitted prior art (modified) and on the mating surface of the admitted prior art (modified). In regard to the limitations of claims 8-9, it is well-known in the molding art to use a recess-forming tool such as a router to form recesses in a preform and to robotically control the recess-forming tool for better control. Further, it is well-known in the molding art to combine shaping and molding operations such as cutting and extruding in order to reduce cycle time and complexity. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redesign the robotically controlled applicator of the admitted prior art to include a recess-forming tool before the applicator in order to achieve the above results. In regard to providing a router having a router bit, such is a mere obvious matter of choice dependent on the equipment

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availability and of little patentable consequence to the claimed method since it is not a manipulative feature or step of the claimed method. Further, the use of a router with a router bit to form recesses is notoriously well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a router with a router bit to form the recesses of the admitted prior art (modified) in order to reduce the complexity of the method. In regard to the specific design claimed in claim 11, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed method since it is not a manipulative feature or of the claimed method. Further, it is well-known in the molding art to apply a buffer material to a first trim that surrounds the second trim and then assembling the trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the first trim part of the admitted prior art to be the trim part that surrounds the second trim part thereby facilitating the mating and bonding of the trim parts of the admitted prior art (modified).

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anderhalden (USPN 4993897) teach the use of a router to form a recess in a preform. Turner (USPN 5899251) and Mitchell et al (USPN 2770386) teach the general idea of mechanically mating two parts.

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Edmund Lee whose telephone number is (703)305-4019. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 4:00 PM.



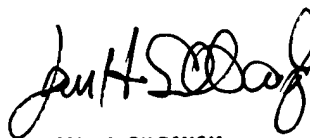
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703)308-3829. The fax phone number for this Group is (703)305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.

EHL

July 31, 2000

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1732

07/31/00